



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,691	12/26/2000	Mitchell R. Swartz		4269

7590 08/29/2003

Mitchell R. Swartz, ScD, MD, EE
16 Pembroke Road
Weston, MA 02493

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance
With 37 CFR 1.192(c)**

Application No.

09/748,691

Applicant(s)

SWARTZ, MITCHELL R.

Examiner

Rick Palabrica

Art Unit

3641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 03 July 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet

Charles T. Jordan
CHARLES T. JORDAN
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20590

Continuation of 9. Other (including any explanation in support of the above items): a. The statement of Status of Amendments is improper. Any arguments that the applicant may wish to make regarding these amendments should be discussed in Argument section rather than in this section. There is no Appendix B, contrary to the statement in this section.

b. The Summary of invention mischaracterizes the claimed invention. Applicant states that the current application is a division of parent application, S/N 07/760,970. The Appeal Brief describes the invention as a method to control the production of desired products (such as "heat"). On the other hand, the parent application discloses the invention as a "novel cold fusion device" that is capable of producing "excess heat". The term, "heat" can mean "joule heat" which is different from "excess heat" produced by the so-called cold nuclear fusion device.

The Summary includes subject matter not found in the specification (see page 7, last three paragraphs).

c. The recitation and scope of Issues is improper. MPEP 1206 states that each stated issue should correspond to a separate ground of rejection which the appellant wishes the Board to review. The statement of issues should not include any argument concerning the merit of the issues. For example, a proper way of phrasing an issue is as follows: "Whether claims 1, 5-8, 10-14 and 21-30 are unpatentable under U.S.C. 101 because the claimed invention is inoperative and therefore lacks unity." Applicant improperly includes other issues not relevant to the grounds of rejection used by the examiner, e.g., U.S. Constitution.

d. The statement on Grouping of Claims is improper because it includes arguments as to why certain claims do not stand or fall together. These arguments should be in the Argument section.

e. The discussion of applicant's contentions in the Argument section is improper. MPEP states, for example, that for each rejection under 35 U.S.C., first paragraph, the argument shall specify the errors in rejection and how said first paragraph is complied with, including as appropriate, how the specification and drawings, if any, a) describe the subject matter defined in each of the rejected claims; b) enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims; and c) set forth the best mode contemplated by the inventor of carrying out the invention. Applicant does not conform to this requirement of cited example of showing how his application complies with the first paragraph.

Not all grounds for rejection of claims are addressed. For example, the examiner rejected new claims 24, 26 and 28 as non-enabling because the specification does not describe how and in what manner the claimed redistribution of isotopic fuel causes the so-called impact on a fuel-impenetrable barrier. This rejection is not specifically addressed in the Appeal Brief, as well as the 35 U.S.C. 103(a) rejection of claims discussed in Section 10 of the Final Office Action, dated 2/3/03.

The Argument section contains irrelevant arguments, e.g., for rejections that have not been made by the examiner (see page 78, last paragraph).

The Argument section does not include arguments as to why certain claims listed in the Grouping of Claims section do not stand or fall together.